

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Eric RASPE et al.

Examiner: SHAFER, SHULAMITH H

Serial No.: 09/720,037

Group Art Unit: 1647

Filed: DECEMBER 20, 2000

Confirmation Number: 7082

Title: **USE OF REV-ERB FAMILY OF RECEPTORS IN SCREENING**

RESPONSE TO RESTRICTION REQUIREMENT

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to this Restriction Requirement mailed June 18, 2008, Applicants hereby elect, with traverse, Group I (claims 1-3 and 9-13), drawn to a method of screening a substance useful in the treatment of lipid metabolism dysfunction comprising contacting comprising contacting said substance with Rev-erb receptor.

Firstly, it is respectfully submitted that, in a generic Markush claim such as, for example, present claim 1, separation of the claim into separate groups (for example, Groups I-III), rather than an election of species, covering the entire scope of the claim, is improper. It is submitted that the restriction requirement violates rules 13.1 and 13.2, as explained in annex B of the administrative instructions under the PCT. Accordingly, it is clear that the restriction requirement must be withdrawn, and the same is respectfully requested.

The requirement for restriction is further traversed insofar as the Office Action has not demonstrated that an undue searching burden would be required to examine

all groups and certainly not to examine at least more than one of the groups (for example, Groups I-IV, which are *generically* directed to a method of screening a substance useful in the treatment of lipid metabolism dysfunction). “If search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct invention.” (Emphasis added.) See, M.P.E.P. §803.

Election of species

Page 4 of the outstanding Office Action requires that Applicants elect a species to comply with the Restriction Requirement. Inasmuch as the Office Action does not “clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted,” this requirement is respectfully traversed. Furthermore, the Office Action is totally silent with respect to why certain species, if even present, are independent or distinct. See, MPEP § 809.02(a).

Although the species requirement is nebulous, in order to comply with the election of species requirement, Applicants elect, with traverse, the aspect of Example 3, which reads on present claim 3.

Should the Restriction Requirement still be maintained, Applicants will seek reentry of any withdrawn claims once allowable subject matter has been determined.

The Commissioner is hereby authorized to charge any fees associated with this response to Deposit Account No. 13-3402.

Respectfully submitted,

/Richard J. Traverso/

Richard J. Traverso, Reg. No. 30,595
Attorney for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: MERCK-2179

Date: June 26, 2008